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EXAMINER

PANDYA, SUNIT

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/670,555	Applicant(s) ROBB, ARTHUR S.	
	Examiner SUNIT PANDYA	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to amendments filed 2/27/09, wherein the examiner acknowledges that claims 1, 14 & 18 have been amended by the applicant, no new claims have been added or canceled. Claims 1-20 are currently pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

Claim 1 states, "A method of conducting an instant win game in combination with a base wagering game comprising:", however claim 1 fails to tie the method step to a statutory class (a game machine), thus, failing the "machine-or-transformation test".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caro et al. (US Patent Pub. 2003/0050109), in view of Mullins (US Patent 5,158,293).

Caro et al. discloses a method of conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof). The disclosed method comprises:

receiving a base wagering game entry and a base wagering game wager from a player, wherein the base game comprises of set of number either selected by the player or are randomly generated (paragraphs [0041-0043]);

receiving an instant win game wager from the player (paragraphs [0041], [0042] and [0045]);

storing a game theme indicator (paragraphs [0041], [0045], [0046] and [0056] wherein memory 22 stores a theme indicator in the form of the type or name of the instant win game selected by the player);

storing a plurality of instant win game outcome display themes (paragraphs [0041], [0045] and [0046] wherein memory 22 stores a plurality of instant win game outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof);

separately generating a second set of game indicia that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia (paragraph [0049], wherein the games are generated separately of each other, and the instant win game is independent of the base wagering game);

the outcome being displayed with one of the plurality of instant win game outcome display themes wherein the one of the plurality of instant win game outcome display themes corresponds to the stored game theme indicator and the base wagering game (paragraph [0049] and Figures 3A and 3B along with the related description thereof); and

awarding the player an instant win game prize corresponding to the outcome of the instant win game (paragraph [0049] and Figures 3A and 3B along with the related description thereof).

However Caro et al. fails to disclose that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game, wherein the theme of the instant win game is different from the theme of the base game (figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious to incorporate the lottery game as taught by Caro et al. into the gaming method taught by Mullins in order to allow players to increase their winnings as

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well as increasing players' interest in the games by implementing different themes between the base game and bonus game.

Regarding claim 2, Caro et al. discloses that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at one of the terminal units (terminals 16). See Figure 1 along with the related description thereof and paragraph [0040].

Regarding claim 3, Caro et al. discloses determining the outcome of the instant win game for the player at one of the host computer (computer 20) and terminal units (terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraph [0049] wherein the computer 20 calculates matches and records results and prizes associated with each ticket 12).

Regarding claim 4, Caro et al. discloses displaying the outcome of the instant win game to the player at one of the terminal units (terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes).

Regarding claim 5, Caro et al. discloses that each terminal unit (terminal 16) includes a ticket printer (paragraph [0040], wherein the terminal 16 print tickets 12) and that the method further comprises printing a ticket (ticket 12) at the printer of one of the terminal units (terminals 16), wherein the ticket includes first set of game indicia

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corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof).

Regarding claim 6, Caro et al. discloses that each terminal unit (terminal 16) includes a video display device (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B. along with the related description thereof).

Regarding claim 7, Caro et al. discloses that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises storing the game theme indicator at one of the host computer (computer 20) and the terminal units (terminals 16). See paragraphs [0041], [0045] and [0046] and Figure 1 along with the related description thereof, wherein computer 20 includes memory 22 which stores a theme indicator in the form of the type or name of the instant win game selected by the player and stores a plurality of instant win game

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outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof.

Regarding claim 8, Caro et al. discloses that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises storing the plurality of instant win game outcome display themes at the terminal units (terminals 16 and paragraph [0041]). See paragraph [0040] wherein terminal 16 is a point-of-sale terminal or a computer. Computers inherently include a processor and a data storage device or memory. The instant win game outcome display themes, e.g., Pick 3 or Pick 4 of Figures 3A and 3B, are communicated from the computer 20 to the terminal 16 (paragraph [0020]) and at least temporarily stored in a memory of the terminal 16 and processed by a processor of the terminal 16 prior to display or printing for the player.

Regarding claim 10, Caro et al. teaches that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at the input device of the terminal (paragraphs [0020] and [0040] wherein player selections made at the terminal 16 are transmitted to the computer 20).

Regarding claim 11, Caro et al. discloses that each terminal unit (terminal 16) includes a ticket printer (paragraph [0040], wherein the terminal 16 print tickets 12) and

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that the method further comprises printing a ticket (ticket 12) at the printer of one of the terminal units (terminals 16), wherein the ticket includes first set of game indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second set of game indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof).

Regarding claim 12, Caro et al. discloses that each terminal unit (terminal 16) includes a video display device (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof).

Regarding claims 9 and 13, Caro et al. discloses a game system including dispensing the instant win game prize to the player via a value dispensing unit (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome) at the terminal (gaming unit 20). Caro et al. also discloses dispensing value to the player, based on the instant win game outcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penrice (US Patent Pub. 2004/0266514), in view of Caro et al. and Mullins.

Penrice discloses a gaming system having a plurality of terminal units (gaming units 20) and a host computer (network computer 22, 32) operatively coupled to the terminal units (Figure 1 along with the related description thereof) over a network 40 to effect play of a lottery game. Penrice teaches that different lottery games can be provided by the gaming system (paragraphs [0058]), which could include those of different themes. However, Penrice does not explicitly teach providing a lottery game that includes a base game and an instant win game. In a related gaming system, Caro et al. teaches a lottery game employed over a network for effecting play of a lottery game having a base game and an instant win game. Caro et al. teaches a lottery game having a base game and an instant win game increases player interest in the game by allowing players to select numbers as in a draw lottery while also receiving immediate results as in an instant win game (paragraphs [0009], [0010] and [0011]. It would have been obvious to incorporate the lottery game as taught by Caro et al. into the gaming system as taught by Penrice in order to increase player interest in the game of Penrice

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by providing a lottery game having a base game and an instant win game as desirably taught by Caro et al. in paragraphs [0009], [0010] and [0011]). Thus, the combination of Penrice and Caro et al. teach a game system for conducting an instant win game in combination with a base wagering game over a network, wherein the computer 22, 32 of Penrice would be programmed to perform the functions of host computer 20 of Caro et al. and wherein the gaming units 20 of Penrice would be programmed to perform the functions of the terminal units 16 of Caro et al.

Regarding claim 14, the combination of Penrice and Caro et al. discloses a game system for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Penrice). The disclosed game system comprises:

- a plurality of terminal units (gaming units 20) and a host computer (computer 22, 32), including a memory (memory 22d) and a controller (MP 22c), operatively coupled to the terminal units (gaming units 20). Each terminal unit (gaming unit 20) comprises:
 - an input device that allows a player to make a plurality of input selections (control panel 66 of Figure 3 along with the related description thereof);

- a terminal unit memory device (memory 106 of Figure 3 along with the related description thereof);

- a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (coin acceptor 52 and bill acceptor 54 of Figure 3 along with the related description thereof);

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a value-dispensing mechanism that is capable of dispensing value to the player (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome);

an output device (ticket printer 56, display 70 and speaker 62 of Figure 3 along with the related description thereof); and

a terminal controller (MP 104 of Figure 3 along with the related description thereof) operatively coupled to the display unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the terminal unit controller (MP 104) is programmed to allow a player to enter a base wagering game entry at the input device (step 554 of Figure 9 along with the related description thereof) and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the terminal unit controller (MP 104) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 20 and also see Caro et al. paragraph [0041]), wherein the terminal unit controller (MP 104) is programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106 and also see Caro et al. paragraph [0041]),

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wherein the terminal unit controller (MP 104) is programmed to separately generating a second set of game indicia that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia (see Caro et al. paragraph [0049], wherein the games are generated separately of each other, and the instant win game is independent of the base wagering game);

wherein the terminal unit controller (MP 104) is programmed to display the outcome of the instant win game at the output device (display 70) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator and the base game, and

wherein the terminal unit controller (MP 104) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

However Penrice fails to teach that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game, wherein the theme of the instant win game is completely different from the theme of the base game (figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious for one with ordinary skill in the art at the time of the invention to implement different themes between the base game and bonus game, as taught by

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Mullins, into a game machine taught by combination of Penrice and Caro et al., to allow players to increase their winnings as well as increasing players' interest in the game.

Regarding claim 15, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a ticket printer (printer 56) and that the method further comprises printing a ticket (ticket 12 of Caro et al. as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 56) of one of the terminal units (gaming units 20), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

Regarding claim 16, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a video display device (display 70) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 20), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 70 in the gaming system taught by Penrice).

Regarding claim 17, the combination of Penrice and Caro et al. teach that the host computer controller (MP 22c) determines the outcome of the instant win game and

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stores the game theme indicator at the memory (memory 22d) and wherein the terminal controller (MP 104) stores a plurality of instant win game outcome themes at the terminal memory (memory 106) and transmits the outcome of the instant win game and the game theme indicator to the terminal unit (gaming unit 20).

Regarding claim 18, the combination of Penrice and Caro et al. teach a terminal unit (gaming unit 20) for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Penrice). The disclosed terminal unit (gaming unit 20) comprises:

- an input device that allows a player to make a plurality of input selections (control panel 66 of Figure 3 along with the related description thereof);

- a terminal unit memory device (memory 106 of Figure 3 along with the related description thereof);

- a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (coin acceptor 52 and bill acceptor 54 of Figure 3 along with the related description thereof);

- a value-dispensing mechanism that is capable of dispensing value to the player (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome);

- an output device (ticket printer 56, display 70 and speaker 62 of Figure 3 along with the related description thereof); and

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a controller (MP 104 of Figure 3 along with the related description thereof) operatively coupled to an output unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the controller (MP 104) is programmed to allow a player to enter a base wagering game entry at the input device, wherein either the player can select the indicia or can be randomly generated (step 554 of Figure 9 along with the related description thereof) and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the controller (MP 104) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 20 and also see Caro et al. paragraph [0041]),

wherein the controller (MP 104) is programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106 also see Caro paragraph [0041]),

wherein the controller (MP 104) is programmed to separately generating a second set of game indicia that is different from the first set of game indicia for play of the instant win game, and determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry and is not dependent upon or

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a function of the first set of game indicia (see Caro et al. paragraph [0049], wherein the games are generated separately of each other, and the instant win game is independent of the base wagering game);

wherein the controller (MP 104) is programmed to display the outcome of the instant win game at the output device (display 70) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator and the base game entry, and

wherein the controller (MP 104) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

However the combination of Penrice and Caro et al. fails to teach that the theme of the instant win game is different from the theme of the base game. In a related gaming method, Mullins teaches a lottery game, wherein the theme of the instant win game is completely different from the theme of the base game (figures 1 & 2, and columns 2-3, lines 30-35, 54-18, wherein different themes for base game and for bonus/instant win game are taught). It would have been obvious for one with ordinary skill in the art at the time of the invention to implement different themes between the base game and bonus game, as taught by Mullins, into a game machine taught by combination of Penrice and Caro et al., to allow players to increase their winnings as well as increasing players' interest in the game.

Regarding claim 19, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a ticket printer (printer 56) and that the method

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further comprises printing a ticket (ticket 12 of Caro et al. as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 56) of one of the terminal units (gaming units 20), wherein the ticket includes first set of game indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second set of game indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

Regarding claim 20, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a video display device (display 70) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 20), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 70 in the gaming system taught by Penrice).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but they are not persuasive.

Applicant's argument that Penrice is not a proper reference because the present application was subject to an assignment, and was assigned to IGT by the sole inventor shortly after filing of the application by way of an assignment executed on October 15, 2003 is not persuasive. The current application was assigned to IGT by the sole inventor AFTER FILING OF THE APPLICATION on October 15, 2003. However the current application has a filing date of September 23, 2003, and the effective date of assignment was after the filing date (9/23/03 vs. 10/23/03). Thus at the time the invention was made, the application was not part of the assignee's ownership and therefore 35 U.S.C. 103(c) does not apply, because 35 U.S.C. 103(c) states that, to invoke 103(c), the applicant must provide that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added)

Regarding the applicant's arguments that the reference of Caro et al. does not include two distinct set of indicia, the examiner respectfully disagrees with the applicant. Caro et al., in figure 2A disclosed below, clearly shows two distinct sets of indicia elements 26 & 30, which are independent of each other. In paragraphs 47 - 49, Caro et al. further discloses of multiple indicia, wherein indicia one is used for an instant win

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game and indicia two is for lottery play. Thus, Caro et al. discloses of two distinct set of indicia.

Regarding the applicant's argument on page 13, that Caro et al. fails to disclose that the outcome for the instant win game is independent of the base wagering game, the examiner respectfully disagrees with the applicant. In paragraphs [0045, 0048-0049], Caro et al. discloses an option for the player to play an instant game as well as a future lottery game, wherein the result of the instant game will not have any effect on the future lottery game, thus making the two games independent of each other. Caro et al. allows for determining of the outcome of the instant win game, wherein the instant win game is independent from the base wagering game, and it is not dependent upon the first set of indicia.

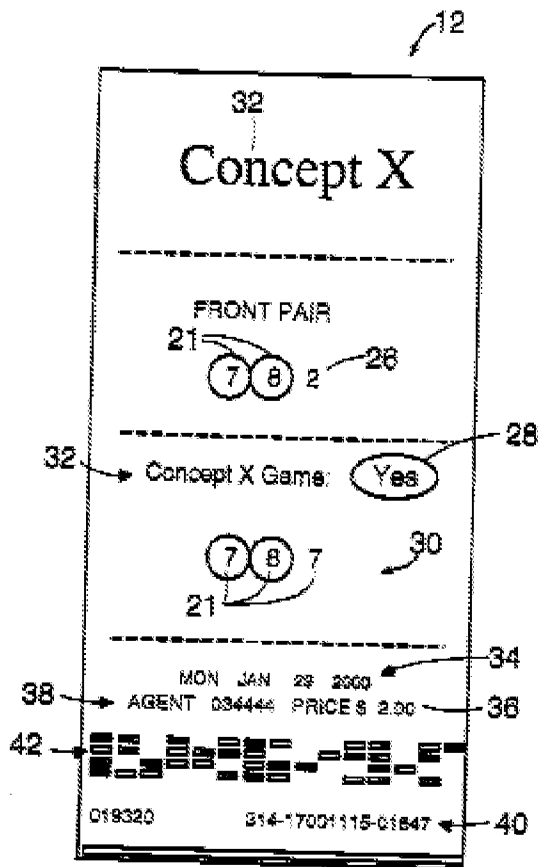


FIG. 2A

Applicant's arguments with respect to claims 1-20 have been considered but deemed non-persuasive, and consequently the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on M-Th 8 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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